

THIS DISPOSITION IS
NOT CITABLE AS
PRECEDENT OF THE TTAB

Mailed:
22 June 2006
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Prestige Cosmetics

Serial No. 76614168

Myron Amer of Myron Amer, P.C. for Prestige Cosmetics.

Ronald E. Aikens, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Hairston, Drost, and Kuhlke, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 29, 2004, applicant Prestige Cosmetics¹
applied to register the mark MULTI-TASK (in standard
character form) on the Principal Register for goods
ultimately identified as "cosmetics, namely, facial
powders" in International Class 3.²

¹ The application identifies applicant as a Florida corporation.

² Serial No. 76614168. The application is based on an allegation
of a bona fide intention to use the mark in commerce.

The examining attorney refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark BIOELEMENTS MULTI-TASK (in typed or standard character form) for "eye creams, eye oils, and eye pads containing eye gel" in International Class 3.³ The registrant is identified as Bioelements, Inc.

When the refusal was made final, applicant filed a notice of appeal.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

³ Registration No. 2,824,126 issued March 16, 2004.

We begin our discussion by comparing applicant's and registrant's goods to determine whether they are related. Applicant's goods are cosmetics, namely facial powder while registrant's goods are eye creams, eye oil, and eye pads containing eye gel. The examining attorney has included evidence to show that these goods, among others, have been registered under a common mark by the same entity. See, e.g., Registration No. 1,826,051 (facial powders and eye cream); No. 2,243,131 (eye creams and facial powders); and No. 2,656,754 (eye creams and facial powders).⁴ These registrations suggest that these goods are associated with a common source. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

A "cosmetic" is defined as "a preparation, such as a face powder or skin cream, designed to beautify the body."

⁴ We have not considered the marks that are not registered or additional marks owned by the same entity.

The American Heritage Student Dictionary (1998).⁵ Applicant identifies its facial powder as a cosmetic. Eye creams and eye oils are cosmetics to the extent that they include products designed to reduce the effects of aging or that cover up or minimize wrinkles and other facial imperfections around the eyes. Facial powder and eye creams and eye oils would be sold together with other cosmetics. They would be sold in the same channels of trade and to the same purchasers who are looking for cosmetics to improve the purchaser's facial appearance.

Applicant disputes that the goods are related and below is applicant's primary argument (brief at unnumbered p. 2) that the goods are not related.

Known from the common experience of shopping, women know the difference between a "cosmetic," used to enhance appearance such as appellant's facial powders, and a medical-type product, used for a medical benefit, such as eye oils, having a perhaps marginal beautifying consequence, or eye pads containing eye gel having no beautifying consequence.

Thus, Applicant argues that the respective goods are significantly different, and that these differences obviate the likelihood of confusion.

Buttressing appellant's position on this point is the reference to the Registrant's IC 003 classification of the below prior U.S. classes:

U.S. 001 Raw or partly prepared materials

⁵ We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

004 Abrasives and polishing materials
006 Chemicals and chemical compositions
050 Merchandise not otherwise classified
051 Cosmetics and toilet preparations
052 Detergent and soaps

Except for the U.S. classification there is nothing that qualifies the recited goods in the '126 Registration as a beautifying cosmetic, and five U.S. classification that dictate otherwise.

First, we note that "The Director may establish a classification of goods or services, for convenience of the Patent and Trademark Office administration, but not to limit or extend the applicant's or registrant's rights." 15 U.S.C. § 1112. Therefore, even the International Class of the goods or services does not limit or expand the rights of the registrant.

Second, the USPTO has now adopted the International Classification system and it assigns an International Class to goods and services in applications. The U.S. class is assigned automatically by a computer based on the International Class. TMEP 1401.04(a) (4th ed. rev. April 2005).

Prior to the adoption of the International Classification in 1973, the U.S. Classification was the primary classification used in the Office. After adoption of the International Classification, the U.S. Classification became a secondary classification system. United States classes are still assigned to all applications by a computerized system. Each international class is coordinated with the U.S. classes that are most frequently associated with it. Neither examining attorneys nor any other Office

personnel have the authority or capability of altering these automatically assigned secondary U.S. Classification designations.

Therefore, these U.S. classes have no significance in a likelihood of confusion analysis.

Third, we point out that the identical U.S. classes have been assigned by the computer to applicant's International Class 3 cosmetics (U.S. 001, 004, 006, 050, 051, and 052).

Fourth, even if there was a problem with the classification of the goods, we must consider the goods as they are described in the registration's and application's identification of goods and services. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). Therefore, we cannot limit registrant's goods to only medical products.⁶ We also note

⁶ We note that applicant does not even suggest that registrant's eye creams are limited to, or primarily, medical products.

that applicant cannot attack the validity of the registration cited against it. In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997).

In addition to the relatedness of the goods, the goods themselves are not restricted in the identifications, and therefore, we must assume that they move through all normal channels of trade for those goods. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989)

("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages").

Furthermore, in order to be related, the goods need only be of such a nature that prospective purchasers will assume that they are associated with a common source.

[G]oods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each [party's] goods or services.

In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

We conclude that facial powder and eye cream and eye oil are related to the extent that if similar marks are used on these items, consumers are likely to believe that they originate from a common source.

Next, we look at applicant's and registrant's marks to determine their similarities and dissimilarities. Both applicant's and registrant's marks contain the identical term MULTI-TASK. It is applicant's entire mark while registrant's mark also contains the term BIOELEMENTS. Applicant argues (Brief at unnumbered p. 3) that its "mark does not use the word BIOELEMENTS and thus does not look, sound like, or have the same connotation of the mark containing this word." The examining attorney argues that applicant's use of the term "MULTI-TASK" for its goods "does not take on a whole new meaning from the registrant's use of 'MULTI-TASK' for its cosmetic goods simply because the applicant has removed the 'BIOELEMENTS' component." Brief at 8.

The term "multi-tasking" is defined as "the concurrent or interleaved execution of two or more jobs by a CPU."⁷ While the term can imply doing two or more tasks at the

⁷ *The Random House Dictionary of the English Language* (unabridged) (2d ed. 1987). We also take judicial notice of this definition.

same time, there is no evidence that the term has any meaning in regard to applicant's or registrant's cosmetics. Indeed, it appears to be somewhat incongruous on these goods.

We do not ignore the fact that registrant's mark also contains another term, BIOELEMENTS. Inasmuch as registrant's name is listed as Bioelements, Inc., this term appears to be a trade name. The addition of a house mark or trade name to a mark may change its commercial impression and may avoid confusion when there are recognizable differences between the common elements of the marks. See Rockwood Chocolate Co. v. Hoffman Candy Co., 372 F.2d 552, 152 USPQ 599 (CCPA 1967) (ROCKWOOD BAG-O-GOLD for candy not confusingly similar to CUP-O-GOLD for candy). On the other hand, adding a house mark may exacerbate the likelihood of confusion. Menendez v. Holt, 128 U.S. 514, 521 (1888) (Addition of "S.O. Ryder" aggravated rather than avoided similarity). We take note of the case of In re Champion International Corporation, 196 USPQ 48 (TTAB 1977). In that case, applicant applied to register the mark CHECK MATE for envelopes. Registration was refused because of the registered mark: HAMMERMILL MICR CHECK-MATE for paper.

It is apparent from the registered mark, as shown above, that the prominent features thereof are the terms "HAMMERMILL" and "CHECK-MATE", with the term "MICR" squeezed between them, and since "HAMMERMILL" is the registrant's house mark and salient feature of its trade name, persons seeking to order the product sold under the particular mark in question would recognize its function as a part of the composite mark and utilize the term "CHECK-MATE" or possibly "MICR CHECK-MATE" to refer to these goods. "CHECK-MATE" therefore forms a viable and recognizable portion of the registered mark and a portion that would serve as an indication of origin for the goods marketed thereunder. Moreover, the fact that applicant's mark comprises "CHECK MATE," per se, militates against its position for another reason basic to the principle that a trademark identifies an anonymous source. This is equated to the realization that the average person does not know the name of the producer of the goods that it purchases. Thus, if persons familiar with "HAMMERMILL MICR CHECK-MATE" paper were to encounter "CHECK MATE" envelopes in the same environment, it is reasonable to assume that they would mistakenly assume that they were "HAMMERMILL CHECK MATE" envelopes.

Id. at 49. See also In re C.F. Hathaway Co., 190 USPQ 343 (TTAB 1976) (HATHAWAY GOLF CLASSIC for knitted sports shirts confusingly similar to GOLF CLASSIC for men's hats); In re Apparel Ventures, Inc., 229 USPQ 225, 226 (TTAB 1986) (Board held that the mark SPARKS and design and SPARKS BY SASSAFRAS and design were similar in sound, appearance, and meaning).

While the marks are different to the extent that registrant's mark contains the trade name BIOELEMENTS, they are similar inasmuch as they contain the common term MULTI-TASK. The presence of this common term results in a mark

that is similar in sound, appearance, meaning, and commercial impression. The term BIOELEMENTS in registrant's mark would likely be viewed as a trade name and its absence in applicant's mark would not result in marks that are dissimilar. If purchasers familiar with registrant's BIOELEMENTS MULTI-TASK eye creams, eye oils and eye pads containing eye gel would encounter applicant's MULTI-TASK facial powders, they are likely to assume that it is simply another cosmetic product of registrant that registrant has chosen to market without its trade name. Therefore, there would be a likelihood of confusion.

Decision: The examining attorney's refusal to register applicant's mark on the ground that there is a likelihood of confusion is affirmed.